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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/748,364
Filing Date: December 30, 2003
Appellant(s): WALKER ET AL.

Jessica Costa
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/27/2008 appealing from the Office action mailed 9/27/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 1-3, 5-6, 8-21, 23-24, 26-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Kaenel in view of Applicant's Own Admission. Appellants refer to US Patent 7107286. However, US Patent 7107285 was used in the rejection.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7107285

VON KAENEL

6-2004

Admitted Prior Art, specification, paragraphs 2-4.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5-6, 8-21, 23-24, 26-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Kaenel in view of Applicant's Own Admission.

Von Kaenal et al. disclose incorporating maps into designs as discussed subsequently.

Von Kaenal et al. do not appear to disclose printing by the vendor.

AOA teaches the feature.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Von Kaenal et al. with AOA because AOA discloses the advantages of using an external print service. See paragraphs 2-3 of the application (background of the art).

Von Kaenal et al. disclose:

making electronic map information available to a server computer system, the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps (fig. 13, 21, 25),

in response to information received from a client computer system identifying a location within the relatively large geographical area, obtaining a relatively high resolution user map from

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the map information, the user map covering a relatively small geographical area that includes at least the identified location (fig. 13, 21, 25, 109, 110, 136, 166),

generating a lower resolution display map version of the user map, the display map being suitable for displaying at the client (col. 65, lines 19-67; screen vs print size),

transmitting the display map to the client for displaying to the user (fig. 13, 21, 25),

receiving a description of an electronic product design from the client, the description identifying at least a portion of the display map (fig. 13, 21, 25, 30-31, 33),

associating the identified portion of the display map with corresponding map information such that the product design will be printed using the higher resolution version of the display map (fig. 13, 21, 25, 30-31, 33),

further comprising storing the obtained user map is stored at the server (fig. 13, 21, 25),

further comprising storing the display version at the server (fig. 13, 21, 25),

further comprising retrieving the stored display version in response to a request from the user and transmitting the display version to the client computer system (fig. 13, 21, 25),

further comprising generating a thumbnail version of the display map and storing the thumbnail version at the server (fig. 13, 21, 25; screen vs print size),

further comprising retrieving the stored thumbnail version in response to a request from the user and transmitting the thumbnail version to the client computer system for viewing by the user (fig. 13, 21, 25; screen vs print size),

wherein the user map is based on location information supplied by the user for the purpose of obtaining a map (fig. 13, 21, 25),

wherein the user map is based on location information extracted from information previously supplied by the user for another purpose (fig. 13, 21, 25; col. 61, lines 8-23),

wherein the information received includes a zoom level to be used to obtain the user map (fig. 13, 21, 25, 92),

wherein the electronic product design has a defined map area and wherein the user map is obtained from the map information at a height and width ratio that corresponds to the height to width ratio of the map area in the electronic product design (fig. 13, 21, 25; col. 65, lines 19-67),

wherein the electronic product design has a defined map area and wherein the display map is generated to have a height and width ratio that corresponds to the height to width ratio of the available map area in the electronic product design (fig. 13, 21, 25).

Von Kaenal et al. does not appear to disclose printing on two sides, as recited, for example, in amended claim 1:

providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user,

providing a tool allowing the user to supply at least text to be printed on the first side,

providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed,

providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area.

Applicants have admitted that it was known to edit various types of common print materials offline and that the editing tools were available.

[0002] Many individuals, businesses, and organizations occasionally have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials. Others may attempt to create the product themselves using specialized software purchased and installed on a personal computer to design the product and using their local printer attached to their personal computer to perform the printing.

A skilled artisan would recognize that the materials commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Von Kaenal et al. teaching to include editing/printing on both sides in the context of the Internet.

As noted by the Court, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103. *KSR Int'l v. Teleflex, Inc.*, 550 U.S. ____ (2007).

"In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. **What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under §103.** One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a

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known problem for which there was an obvious solution encompassed by the patent's claims." *KSR Int'l v. Teleflex, Inc.*, 550 U.S. ____ (2007).

Applicants have admitted that there is a known problem, namely the need for custom printed materials, and that it is known and desirable to do so with various editing tools, without the internet:

[0002] Many individuals, businesses, and organizations occasionally have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials. Others may attempt to create the product themselves using specialized software purchased and installed on a personal computer to design the product and using their local printer attached to their personal computer to perform the printing.

Applicants have admitted that it is known and desirable to do so on the internet with various editing tools.

[0003] An increasingly popular alternative for obtaining these types of materials is the use of a Web-based printing service provider that takes advantage of the capabilities of the Web and modern Web browsers to provide document design services from any computer with Web access at whatever time and place is convenient to the user. Computerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized product design. Typically, a user can add, modify, and position custom text and upload images to be added to the electronic product design. When a user is satisfied with the design of the product, the user can place an order with the printing service provider for the production of a desired quantity of high quality printed versions of the product to be delivered to the customer's home or business.

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[0004] In another computer-related field, high quality mapping software is available from various vendors either online or on a CD or other media and mapping software applications have become common. Examples include mobile applications, like handheld and automotive map systems using global positioning technology, and commercial establishment applications, such as customized driving maps printed at car rental offices for individual customers. In the Web environment, various free services available on the Web, such as MapQuest.com and Yahoo.com, allow an individual to enter a street address and view a corresponding map. Tools to modify the displayed map by zooming or scrolling are also commonly provided. Businesses maintaining Web sites frequently incorporate access to a mapping service to display maps for stores and custom driving directions from an address entered by the user.

It would have been obvious to one of ordinary skill in the art at the time of the invention to practice the claimed invention.

In *Kahn*, the court affirmed the PTO's finding of obviousness, explaining at great length that a "teaching, suggestion, or motivation" can be found "implicitly" based on precisely the factors that the Solicitor General says are relevant: "*what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.*" 441 F.3d 987

In *Dystar Textilfarben v. C.H. Patrick* (06-1088), the court explained, "an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the 'improvement' is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient." (emphasis added). In this case, the "problem" facing those in the art, and the solution was known:

[0003] An increasingly popular alternative for obtaining these types of materials is the use of a Web-based printing service provider that takes advantage of the capabilities of the Web and modern Web browsers to provide document design services from any computer with Web access at whatever time and place is convenient to the user.

Computerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized product design. Typically, a user can add, modify, and position custom text and upload images to be added to the electronic product design.

When a user is satisfied with the design of the product, the user can place an order with the printing service provider for the production of a desired quantity of high quality printed versions of the product to be delivered to the customer's home or business.

(10) Response to Argument

Applicant's arguments, filed 3/27/2008, have been carefully considered but are not persuasive. The relevant sections (and corresponding arguments) of the Brief are listed; the response to arguments follow. It is first noted that all arguments presented in the Appeal Brief are new (compare to the response of 7/12/2007).

Section A: pages 17-20: no arguments.

Section B. Response to Rejection of Claims Under 35 USC 103 (pages 20-21):

Appellants cite case law. No specific arguments presented.

Section B-1. Response to Rejection of Claims Under 35 USC 103 (pages 21-24):

Inventor's Own Work May not be considered prior art by admission:

Appellants argue (page 22):

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the patentee's own patent in both the specification section entitled "Summary of the Prior Art" and in the preamble to a Jepson claim. The *Reading & Bates* court held ... that the patentee's discussion of his own patent in the specification section entitled "Summary of the Prior Art" did not constitute an admission that the patent was prior art. In reaching its conclusion, the court reviewed our precedent and recognized the "policy behind requiring a statutory basis before one's own work may be considered as prior art." *Id.* at 650, 223 USPQ at 1171 (citing *In re Fout*, 675 F.2d 297, 213 USPQ 532).

The fact patterns are different. The '440 specification (see par. 37 of the *Reading & Bates* case) *expressly and specifically referenced* the inventor's own work:

In addition to the district court's basis for holding the '903 patent to be prior art, Baker asserts that the section of the '440 specification entitled "Summary of the Prior Art," made reference to the method disclosed in the '903 patent. That portion of the specification reads as follows: It has heretofore been unknown to use such overshoes [following liner] in drilling inverted arcuate paths underneath obstacles, as illustrated in my U.S. Pat. No. 3,878,903 for APPARATUS AND PROCESS FOR DRILLING UNDERGROUND ARCUATE PATHS. The purpose of the following liner in this context is to maintain the drilled hole and provide a second larger drill pipe to be used as a production casing or for subsequent reaming of the hole. Accordingly, the invention summarized hereafter is believed to radically distinguish from the known prior art.

There is no such reference in the section entitled "Background of the Invention" of the instant specification, and there is no statement anywhere in the specification (or in the entire record) that would suggest otherwise.

MPEP section 2129 is relevant:

2129 Admissions as Prior Art [R-6]

I. ADMISSIONS BY APPLICANT CONSTITUTE PRIOR ART

A statement by an applicant in the specification or made during prosecution identifying the work of

another as "prior art" is an admission which can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted

Consequently, the examiner must determine whether the subject matter identified as "prior art" is applicant's own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another.

No credible explanation has been put forth by Appellants. Furthermore, the wording of paragraphs 2-4 clearly demonstrates that Appellants were referring to the work of others. Note the use of *commonly, commonly provided, typically, increasingly popular, available from various vendors, free services available, businesses ... frequently incorporate access*, in a few examples:

[0002] Many individuals, businesses, and organizations occasionally have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials. Others may attempt to create the product themselves using specialized software purchased and installed on a personal computer to design the product and using their local printer attached to their personal computer to perform the printing.

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[0003] An increasingly popular alternative for obtaining these types of materials is the use of a Web-based printing service provider that takes advantage of the capabilities of the Web and modern Web browsers to provide document design services from any computer with Web access at whatever time and place is convenient to the user.

Computerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized product design. Typically, a user can add, modify, and position custom text and upload images to be added to the electronic product design. When a user is satisfied with the design of the product, the user can place an order with the printing service provider for the production of a desired quantity of high quality printed versions of the product to be delivered to the customer's home or business.

[0004] In another computer-related field, high quality mapping software is available from various vendors either online or on a CD or other media and mapping software applications have become common. Examples include mobile applications, like handheld and automotive map systems using global positioning technology, and commercial establishment applications, such as customized driving maps printed at car rental offices for individual customers. In the Web environment, various free services available on the Web, such as MapQuest.com and Yahoo.com, allow an individual to enter a street address and view a corresponding map. Tools to modify the displayed map by zooming or scrolling are also commonly provided. Businesses maintaining Web sites frequently incorporate access to a mapping service to display maps for stores and custom driving directions from an address entered by the user.

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Appellants argue:

However, to the extent that these paragraphs actually teach anything, the computerized systems for creating customized product designs, as referred to in paragraph [0003], is the Applicant's own work. In paragraph [0021] of the Applicant's Specification, reprinted below for the convenience of the reader, the Applicant refers to the computerized product design program as being provided by VistaPrint, Limited, the assignee of record in the present application.

[0021] When UCS 100 is operating, an instance of the USC 100 operating system will be running, represented in Fig. 1 by operating system 103. In addition, the user may be running one or more application programs. In Fig. 1, UCS 100 is running Web browser 105, such as Internet Explorer from Microsoft Corporation. Other applications that may be running in USC 100, such as spreadsheet, e-mail, and presentation programs, are represented as applications 104. In the depicted embodiment, design tool 106 is a product design program downloaded to UCS 100 via network 120 from remote server 110, such as downloadable design tools provided by VistaPrint Limited and publicly available at vistaprint.com....

Figure 1 is not discussed in the background of the invention and is not mentioned until the section entitled "Detailed Description". There is no reference, *express or otherwise*, in any part of the detailed description, to the background section. In any case, it is noted that the use of "such as downloadable design tools provided by VistaPrint..." indicates that other similar design tools were also available in addition to those available from assignee.

It should be pointed out that paragraph 21, recited above by Appellants, actually corresponds to paragraph 20 of the instant specification (see specification, 12/30/2003 as well as the prepublication 20050147442).

Appellants argue (page 23):

Indeed, each of the following U.S. Patents describe the computerized systems for creating customized product designs referred to in the present application, and are assigned to the same assignee of record as the present application:

...

Accordingly, since the alleged AOA is in fact a description of the applicant's own work, per In Re Land, supra, the relevant disclosure is not an admission of prior art, and thus it cannot be used in establishing a prima facie case of obviousness in the present application.

The argument is not understood and the conclusion is not supported by any rationale or facts. Whether or not the material in the section entitled "background of the invention" may also be present in Appellants' issued patents is not determinative of whether the material in question is solely (if at all) the inventor's prior work. The references (page 24, Appeal Brief) are not mentioned in the background section and were not brought to the attention of the office during prosecution.

It is noted that this is the first time this argument has ever been presented. The rejection (the 103 based upon application's admission) was asserted in the non-final action of 1/17/2007. Applicants responded to the rejection on 7/12/2007, stating only:

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The claims of the pending application have been amended to clarify that the claimed methods and systems are not directed to merely generating and viewing an online map image and then printing a copy of it, but rather to methods and systems for allowing a user to perform online design of a customized, two-sided product to be printed, the overall product design having as one component a user-customizable map area.

Appellants were silent, in their response, as to whether they believed the disclosure in the “Background of the Invention” constituted Appellant’s own work. The silence was taken as acquiescence. Furthermore, there was no submission in the IDS of 4/21/2006 of anything relating to the inventor’s own work. Appellants did not properly challenge, in a timely manner, the finding that paragraphs 2-4 constitutes admission.

Section B-2. Response to Rejection of Claims Under 35 USC 103 (pages 24-39):

Prior Art does not teach claimed invention:

Paragraphs 2-4 of the specification disclose the state of the art.

[0002] Many individuals, businesses, and organizations occasionally have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials. Others may attempt to create the product themselves using specialized software purchased and installed on a personal computer to design the product and using their local printer attached to their personal computer to perform the printing.

[0003] An increasingly popular alternative for obtaining these types of materials is the use of a Web-based printing service provider that takes advantage of the capabilities of the Web and modern Web browsers to provide document design services from any computer with Web access at whatever time and place is convenient to the user.

Computerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized product design. Typically, a user can add, modify, and position custom text and upload images to be added to the electronic product design. When a user is satisfied with the design of the product, the user can place an order with the printing service provider for the production of a desired quantity of high quality printed versions of the product to be delivered to the customer's home or business.

[0004] In another computer-related field, high quality mapping software is available from various vendors either online or on a CD or other media and mapping software applications have become common. Examples include mobile applications, like handheld and automotive map systems using global positioning technology, and commercial establishment applications, such as customized driving maps printed at car rental offices for individual customers. In the Web environment, various free services available on the Web, such as MapQuest.com and Yahoo.com, allow an individual to enter a street address and view a corresponding map. Tools to modify the displayed map by zooming or scrolling are also commonly provided. Businesses maintaining Web sites frequently incorporate access to a mapping service to display maps for stores and custom driving directions from an address entered by the user.

Appellants acknowledge (pg. 27, brief) that Von Kaenel discloses downloading and displaying maps:

Thus, because Von Kaenel discloses only combining multiple image layers to display a composite "map" image, Von Kaenel does not teach or suggest "obtaining a relatively high resolution user map from the map information."

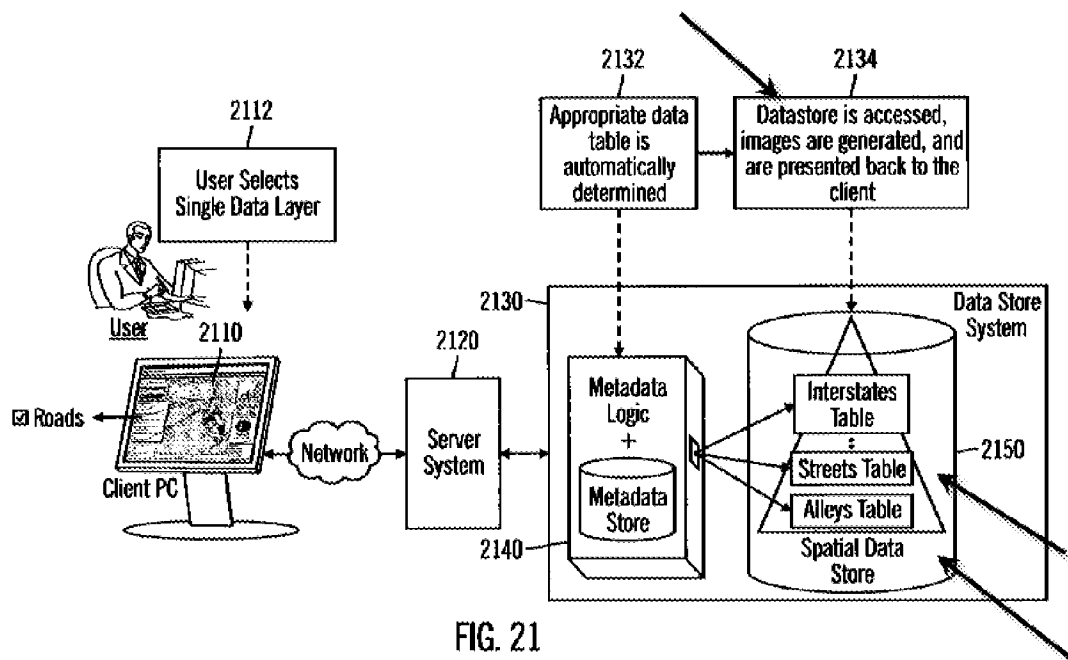
Applicants also acknowledged this in their response of 7/12/2007:

The von Kaenel reference discloses a system for storing and retrieving spatial data, including map images. For example, as generally depicted in Fig. 13 and described at col. 27, line 27 to col. 28, line 2, a user can submit a request to a server to view selected information, which will typically be returned by the server as a number of image layers that are combined into a single image at the client computer. As depicted in Fig. 25 and described at col. 44, line 48 to col. 45, line 6, the von Kaenel reference describes allowing the user to print a copy of a displayed image. The von Kaenel server creates the printable file and sends it to the user's computer for local printing by the user.

Appellants argue (pg. 27, brief):

Von Kaenel's FIG. 21 illustrates user selection of a single data layer, in particular, the "roads" data layer, which results in a request for the "roads" data layer being sent to the server system 2120. The server determines which data tables to use for the request using metadata logic and metadata, accesses the data tables, generates image layers for the requested "roads" data layer, and returns the image layers to the client for display. (Von Kaenel, col. 41, line 57 – col. 42, line 3). As illustrated in FIG. 21, the "roads" data layer includes data from the Interstates Table, the Streets Table, and the Alleys Table, resulting in an Interstates image layer, a Streets image layer, and an Alleys image layer -- that is, multiple image layers (which correspond to the single "roads" data layer). Again, however, the client software 2110 must combine the multiple image layers to generate the composite "map" image displayed to the user.

See figure 21:



Claim 1 recites:

in response to information received from the client computer system:
 identifying a location within the relatively large geographical area, obtaining a
 relatively high resolution user map from the map information, the user map
 covering a relatively small geographical area that includes at least the identified
 location,

It is noted that the use of “relatively” allows for a broad interpretation of the claim with respect to resolution. The claim does not require or preclude that single/multiple data layers be used (note that “comprising” is used as the transitional phrase in the claims). Regardless, a single layer with only “roads” is still a map, as is each of the layers in question. Finally, it has generally been recognized that merely making integral is not sufficient to distinguish over the prior art, *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). Appellants further argue (pg. 27):

Thus, because Von Kaenel discloses only combining multiple image layers to display a composite "map" image, Von Kaenel does not teach or suggest "obtaining a relatively high resolution user map from the map information."

It is not seen how this conclusion is warranted – the relevant issue pertains to the *resolution of the layers*. In any case, the rejection stated:

9. Von Kaenel et al. disclose:

making electronic map information available to a server computer system, the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps (fig. 13, 21, 25),

The text describing fig. 25 (col. 44, line 47 to col. 45, line 6):

H. Printing Multiple Data Layers

Implementations of the invention allow for multiple data layers to be printed. FIG. 25 illustrates logic for printing multiple data layers in accordance with certain implementations of the invention. Control begins at block 2510 with the client software receiving a user request to print a composite image that is formed by overlaying multiple data layers. In particular, when a user clicks on a Print menu to print different data layers that are displayed on a Map Control window, the client software receives the print request. In block 2512, the client software sends the print request to the server system. In block 2514, the server system receives and processes the print request by gathering all of the requested data layers and combining the multiple data layers as one printable file. Then, in block 2516, the server system sends the combined printable file to the client software to print. In block 2518, the client software receives and prints the printable file.

5 In certain implementations, for handling a Print Preview menu selection by a user, the client software and the server system perform logic similar to the logic used for processing

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a Print menu selection, but lower resolution data may be used to achieve faster performance, and rather than printing a printable file, the client software displays the printable file.

In summary, for printing multiple data layers, the client software and the server system support printing multiple data layers as one printable file.

Appellants argue (pg. 27, brief):

Second, Von Kaenel does not teach or suggest anything about the relative resolutions of displayed and printed composite images. As explained above, Von Kaenel retrieves multiple image layers corresponding to one or more data layers. The individual image layers are sent directly to the client for display to the user. The Office Action cites Von Kaenel, col. 65, lines 19-67 as teaching "generating a lower resolution display map version of the user map." The Applicant respectfully disagrees. Col. 65, lines 19-67 of Von Kaenel discusses only the differences between the number of pixels available in enterprise spatial system workspace of the user interface (UI) screens (when displayed in the 800x600 resolution mode) when a vertical scroll bar is either displayed or not displayed on the UI screen. However, this teaches nothing about the relative resolutions of the image layers obtained by the server and those displayed to the user by the client. In fact,

The section in question (col. 65) discloses the (standard) screen resolution which is lower than that commonly used for printing. This is buttressed by lines 1-18 of the same column which disclose that the screen resolution can only approximate the resolution of the document (lines 9-11).

See fig. 39, where the screen provides for a very low resolution (about 350 kB), much lower than commonly used in printing detailed documents such as maps. It is not clear that the resolution of printers can even be set that low.

As for the resolution of the maps, the rejection stated:

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9. Von Kaenal et al. disclose:

making electronic map information available to a server computer system, the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps (fig. 13, 21, 25).

The text describing fig. 25, recited in the rejections, (col. 44, line 47 to col. 45, line 6):

H. Printing Multiple Data Layers

Implementations of the invention allow for multiple data layers to be printed. FIG. 25 illustrates logic for printing
multiple data layers in accordance with certain implementations of the invention. Control begins at block 2510 with the client software receiving a user request to print a composite image that is formed by overlaying multiple data layers. In particular, when a user clicks on a Print menu to
print different data layers that are displayed on a Map Control window, the client software receives the print request. In block 2512, the client software sends the print request to the server system. In block 2514, the server system receives and processes the print request by gathering
all of the requested data layers and combining the multiple data layers as one printable file. Then, in block 2516, the server system sends the combined printable file to the client software to print. In block 2518, the client software receives and prints the printable file.

In certain implementations, for handling a Print Preview menu selection by a user, the client software and the server system perform logic similar to the logic used for processing

a Print menu selection, but lower resolution data may be used to achieve faster performance, and rather than printing a printable file, the client software displays the printable file.

In summary, for printing multiple data layers, the client software and the server system support printing multiple data layers as one printable file.

Appellants argue (page 29, brief):

Von Kaenel also does not teach or suggest "receiving a description of the product design from the client, the description identifying at least a portion of the display map." In contradistinction to Applicant's claimed limitation, the client 1310 in Von Kaenel's system does not supply any description of a product design. Rather, as illustrated in FIG. 13, the client merely generates a request of the server for information such as customer information and locations in a specific sales territory, data sets for each of customer information 1332, roads information 1331, and sales territory boundaries 1333. The server retrieves the appropriate data set(s) corresponding to the request from data store 1330 and each is transformed into a spatially referenced image (e.g., bitmap, JPEG, TIFF, etc.). (Von Kaenel, col. 27, lines 40-51). However, the actual request from the client, which is the only element received by the server, is not a "description of the product design" as required by Applicant's Claim 1 because it does not describe an actual "design" of a product. Rather, the request describes only relevant data of which the client seeks.

The patentable distinction is not seen. The request itself constitutes design intent because the user is requesting certain information to be provided in an electronic document in a specific manner. In any case, the specification broadly defines 'product':

[0025] Fig. 2 is a simplified representation of an introductory product selection page being viewed by the user of UCS 100 on user display 140. In this example, the page displays and promotes various products available from the service provider and offers active controls that allow the user of UCS 100 to select a desired type of product for a more detailed presentation of design options. By way of example, Fig. 2 shows promotional images for business cards 210, postcards 220, stationery 230, folded cards 240, return address labels 250, and brochures 260. Images or promotions for fewer, different or additional products, such as presentation folders, invitations, announcements, thank you cards, gift tags, and so forth could also be presented along with other information and buttons. It will be understood that the invention is not limited to documents that are intended for eventual printing on paper, but could as well be readily adapted to a wide range of products that a user may wish to customize, such as items of clothing, product containers, promotional goods, and so forth.

Appellants argue (pg. 30, brief):

In contrast to Applicant's recited "product design", however, the combined background with editable layer 3040 is not "a description of the product design."
Rather, it is a user-requested image of spatially referenced data with an editable image layer. The user-requested image of spatially referenced data is not incorporated into any "product design" but rather is displayed on its own. There is no indication whatsoever that the user-requested image of spatially referenced data is incorporated into and displayed in any product design image.

The patentable distinction is not seen. The claims also call for spatially referenced data (map), but do not additionally call for an editable layer. To argue that editing of the map implies that the document is not being designed is not credible. To the contrary, editing a map in the electronic document means, by itself, that the document is being designed. It is also noted that Maps constitute non-functional descriptive material.

Appellants' arguments on pages 31-32 do not actually address the issues discussed therein. For example, page 32:

The Examiner then states that

"Applicants have admitted that it was known to edit various types of common print materials offline and that the editing tools were available (See Office Action, page 5, paragraph 11),

and from this concludes that

"[a] skilled artisan would recognize that the materials commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material." (See Office Action, page 5, paragraph 12).

The Examiner's focus on only the "two-sided" feature in the claims does not reasonably reveal to the Applicant where in the alleged AOA there exist

The Examiner did not 'conclude' as alleged above. The Examiner took notice that

A skilled artisan would recognize that the materials commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in

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printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material.

And thus concluded

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Von Kaenal et al. teaching to include editing/printing on both sides in the context of the Internet.

Appellants are still silent about whether:

A skilled artisan would recognize that the materials commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material.

And thus have not properly challenged the finding. See MPEP **2144.03 (Reliance on**

Common Knowledge in the Art or “Well Known” Prior Art). Note 2144.03 (A):

A. Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support the Examiner's Conclusion

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court

Appellants did not even attempt to challenge the finding, and only stated (7/12/2007):

The claims of the pending application have been amended to clarify that the claimed methods and systems are not directed to merely generating and viewing an online map image and then printing a copy of it, but rather to methods and systems for allowing a user to perform online design of a customized, two-sided product to be printed, the overall product design having as one component a user-customizable map area.

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If

Regarding the 'focus on the "two-sided"' feature, Appellants are reminded that their only argument (7/12/2007) was that the patentable distinction over the Von Kaenel reference was in 1) *using both sides* and 2) *allowing for the ability to edit the (to be printed) map* (see above) in the document.

Applicants have admitted in the specification that there is a known problem, namely the need for custom printed materials:

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[0002] Many individuals, businesses, and organizations occasionally have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials. Others may attempt to create the product themselves using specialized software purchased and installed on a personal computer to design the product and using their local printer attached to their personal computer to perform the printing.

and that it is known to do so on the internet with various editing tools.

[0003] An increasingly popular alternative for obtaining these types of materials is the use of a Web-based printing service provider that takes advantage of the capabilities of the Web and modern Web browsers to provide document design services from any computer with Web access at whatever time and place is convenient to the user. Computerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized product design. Typically, a user can add, modify, and position custom text and upload images to be added to the electronic product design. When a user is satisfied with the design of the product, the user can place an order with the printing service provider for the production of a desired quantity of high quality printed versions of the product to be delivered to the customer's home or business.

The rejection further stated:

As noted by the Court, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was

obvious under §103. *KSR Int'l v. Teleflex, Inc.*, 550 U.S. ____ (2007).

"In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under §103. One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *KSR Int'l v. Teleflex, Inc.*, 550 U.S. ____ (2007).

In this respect, the Examiner notes that an atlas includes text and maps on both sides of the pages.

It is well established that people commonly write on both sides of a piece of paper. It is also well established that people commonly print on both sides of a piece of paper. A skilled artisan would recognize that printing materials usually include two sides, and would recognize the advantages in printing on both sides including, for example, the ability to provide more information to a customer in one piece of printed material.

It is noted that this is the first time these arguments have ever been presented in response to the rejection first asserted in the non-final action of 1/17/2007.

Section B-3. Response to Rejection of Claims Under 35 USC 103 (pages 40-41): AOA admission is not enabling:

Appellants state (pg. 40):

The alleged AOA includes paragraphs [0002] and [0003] of the Applicant's Specification. There is nothing in either of these two paragraphs that would enable one of ordinary skill in the art at the time of the invention to perform the steps of "providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, *the second side of the product having a map area where a map will be printed when the product is printed*, or providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area." The alleged AOA statement in

This is mere allegation. Appellants have not provided a specific argument, evidence or expert testimony. This is not a credible statement. The Examiner notes that an *atlas* includes text and maps on both sides of the pages and such products are common.

The AOA admission is a statement regarding the state of the art and what was already known and already performed (which Appellants argue was their own work) – it was therefore, *by definition* 'operable'.

Prior Art is presumed to be operative/enabling. See MPEP 2121:

>
**I. < PRIOR ART IS PRESUMED TO BE
OPERABLE/ENABLING**

When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07.

Appellants did not attempt to rebut the presumption of operability in their response (7/12/2007) to the rejection. They provide no facts in this appeal brief.

MPEP 2121 further states:



A prior art reference provides an enabling disclosure and thus anticipates a claimed invention if the reference describes the claimed invention in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention; “proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation.” *Impax Labs. Inc. v. Aventis Pharm. Inc.*, 468 F.3d 1366, 1383, 81 USPQ2d 1001, 1013 (Fed. Cir. 2006). See also MPEP § 2122.<

The importance of the admission in the specification is not as much about what it teaches, but, rather what it says about *what was known to one of ordinary skill in the art at the time of the invention*.

Appellants argue:

Even if the discussion at paragraphs [0002] and [0003] in the Applicant's Specification were considered by the Board to be prior art, the combined alleged “AOA” is not enabling as to the limitations of the claimed invention missing from the Von Kaenel reference. It is well settled that although published subject matter is “prior art” for all that it discloses, in order to render an invention unpatentable for obviousness, the prior art must enable a person of ordinary skill to make and use the invention. *In re Kumar*, 418 F.3d 1361, 76 USPQ2d 1048, 1052-53 (Fed. Cir. 2005) (citing *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301 (Fed. Cir. 1989) (emphasis added)). Thus when a prima facie case of obviousness is deemed made based on similarity to a known composition or device, rebuttal may take the form of evidence that the prior art does not enable the claimed subject matter. *Id.* See *In re Payne*, 606 F.2d 303, 314-315

A more accurate portrayal of the relevant court decisions is presented in MPEP 2121.02 which addresses the situation where the reference might be found inoperative:

“Even if a reference discloses an inoperative device, it is prior art for all that it teaches.” *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, “a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103.” *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991).

In any case, the claims are not drawn to a composition or device.

Appellants further argue:

not enable the claimed subject matter. *Id.* See *In re Payne*, 606 F.2d 303, 314-315 (CCPA 1979) (“the presumption of obviousness based on close structural similarity is overcome where the prior art does not disclose or render obvious a method for making the claimed compound”); *In re Hoeksema*, 399 F.2d 269, 274 (CCPA 1968) (“the absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structures and those of prior art compounds”).

This is an abstract argument. In any case, the fact patterns are different. The claims in the cited cases appear to be directed to ‘product’ claims, while the instant claims are drawn to either ‘method’ or ‘system’ claims.

This is the first time that these arguments been presented.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

/Hugh Jones/

Primary Examiner

Art Unit 2128

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